

REMARKS

Receipt of the final rejection mailed July 17, 2007 is acknowledged. Claims 3-11 are pending on the application and have been rejected as anticipated by the Taylor reference. In keeping with the foregoing amendment and the following argument, reconsideration and allowance is respectfully requested.

Applicant respectfully points out that the foregoing amendments to claim 8 were not presented earlier for good and sufficient reason. The final rejection contains explicit reasoning regarding how the examiner is reading the claims and how the examiner is interpreting the Taylor reference. Further, the Taylor reference is newly-cited. This more explicit reasoning has made it apparent to the applicant that the Examiner may not have accorded full meaning to the claim limitations regarding the thicknesses, the step, etc. Therefore, the present after-final amendment should be entered in its entirety.

The rejection of claim 3 is traversed. Claim 3 positively recites, in part, that “the opening end portion is partially expanded in the radial direction to have a thickness larger than a thickness of a base end side portion of the core body,” that “a step portion [is] formed between the opening end portion and the base end side portion of the core body to form a right angle between the step portion and the base end side portion,” and that “diamond grains [are] bound on the opening end portion from an inner peripheral side of the core body to an outer peripheral side of the core body.” All three of these limitations are readily apparent upon viewing Fig. 3 of the present application. Thus, claim 3 clearly recites that:

- 1) the opening end portion is thicker than the base end side portion;
- 2) a step forms a right angle between the opening end portion and the base end side portion; and
- 3) diamond grains extend from the inner peripheral side to the outer peripheral side.

The action refers to Figs. 1, 2 and 3 of Taylor. The lower portion of Fig. 1 shows that the bottom portion is thicker than the generally cylindrical, smooth-walled top

portion. However, this smooth-walled top portion is not the “base end side portion” at all. Instead, the smooth-walled top portion fits within the bottom of the steel shank 22, as shown in Figs. 2 and 3. Thus, the smooth-walled top portion cannot possibly be a “base end side portion,” because the smooth-walled top portion sits inside the steel shank 22.

Next, Fig. 3 shows that the smooth outer wall of the steel shank 22 extends all the way down to meet the diamond grains. Therefore, there is no step “between the opening end portion and the base end side portion of the core body” as claimed.

Moreover, on Taylor the diamond grains terminate below the “step.” Consequently, the diamond grains do not appear to extend to the outer peripheral side as claimed.

Finally, there cannot be a proper *prima facie* case of obviousness based on Taylor. In order to reach the claimed invention, one would have to make extensive modifications to the Taylor device, such as changing the relative thicknesses of the component parts, and changing the construction to move the purported “step” of Taylor from a position inside the outer wall of the steel shank 22 to a position on the outside of the steel shank 22. Any such modifications would be based on applicant’s disclosure, and would completely alter the principle of operation of Taylor and would run counter to the expressly claimed method of Taylor.

For the foregoing reasons, the rejection of claim 3 is improper and must be withdrawn. Claim 3 is in allowable form, as are the claims dependent on claim 3.

Claim 8 has been amended to positively recite, in part, that the tip end includes a radially expanded part having a thickness greater than a thickness of the side wall of the core body, and that the radially expanded part terminates at a step extending beyond the side wall.

By comparison, as outlined above with respect to claim 3, the lower portion of Fig. 1 of Taylor shows that the bottom portion is thicker than the generally cylindrical, smooth-walled top portion. However, that smooth-walled top portion is not and cannot be the side wall. Viewing Figs. 2 and 3, Taylor shows the radially expanded part is at most the

same size as the sidewall thickness, and does not show the radially expanded part is thicker than the sidewall as claimed.

Moreover, on Taylor the purported “step” does not extend “beyond the side wall” as claimed by amended claim 8. Instead, the step resides well inside of the side wall at all times. Consequently, claim 8 defines over the Taylor reference, and is in allowable form. Moreover, there can be no proper *prima facie* case of obviousness based on Taylor for at least the reasons outlined above.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Dated: September 18, 2007

Respectfully submitted,

By 

David C. Read

Registration No.: 39,811

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant